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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,963	11/20/2006	James Mathew Hodgson	005127.00587	4250
22509	7590	10/15/2009	EXAMINER	
BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			LALLI, MELISSA LYNN	
ART UNIT	PAPER NUMBER	3728		
MAIL DATE		DELIVERY MODE		
10/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,963	<b>Applicant(s)</b> HODGSON, JAMES MATHEW
	<b>Examiner</b> MELISSA L. LALLI	<b>Art Unit</b> 3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 August 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 25-29 and 34-42 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 25-29 and 34-42 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 30 December 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 11/22/06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Election submitted August 25, 2009 has been acknowledged. In response to the Restriction Requirement, applicant has elected Invention I, claims 25-42, drawn to a product, without traverse. In response to the Election of Species Requirement included in that same paper, applicant has elected Species (.A), Figs. 1-3, without traverse. Claims 25-29 and 34-42 read on this elected species. Claims 30-33 and 43-47 have been canceled; hence, claims 25-29 and 34-42 are pending.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "one or more straps attached to an upperside of the toe part" of claim 41 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 34, 35, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 34 and 37, the limitation "the instep side supports...otherwise being open" as stated on lines 4-5 and lines 2-3 respectively is indefinite and misleading. It is unclear what structure is encompassed by the phrase "otherwise being open"? Applicant is required to clarify and amend the claims as necessary.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Ehrlich, Jr. (Ehrlich).

Regarding claim 25, Ehrlich discloses a sole (fig. 2) for footwear comprising: a toe part (1) made of a substantially inflexible material; a ball part (3) being made of a flexible material, and an instep-heel part (2) being made of a substantially inflexible material (see lines 1-4 of the abstract).

7. Claims 25 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Oorei.

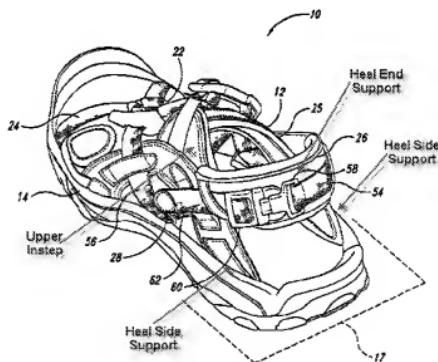
Regarding claims 25 and 29, Oorei discloses a sole (1) for footwear comprising: a toe part (C) made of a substantially inflexible material; a ball part (F) being made of a flexible material, and an instep-heel part (A, B, & D) being made of a substantially inflexible material (paragraph [0034]). A plurality of spikes are attached to the toe part (41-44 and paragraph [0037])

8. Claims 34-39, 41, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by each of Bathum and Matis.

Regarding claims 34-37, Bathum and Matis each disclose an article of footwear (10; 40) comprising: a sole (16; 42) having a toe part (33; at 66), a ball part (40; fig. 5, at 42), an instep part (38; fig. 5, at 80), and a heel part (17; fig. 5, at 64); an open toe section (figs. 1, 2, & 8; figs. 4-6); an instep section (12; 48) having two instep side supports (fig. 8, at 28 and not shown opposite; fig. 7, sections of 128 which attach to slots 74 & 48), the instep side supports being connected to the instep part of the sole

and otherwise being open (figs. 1 & 8; figs. 4-6); and a heel section (26; fig. 7, at 128), wherein the heel section has two heel side supports and an end heel support (see annotated fig. below; fig. 7, sections of 128 which attach to slots 72 & 76 and section of 128 at 128), and the two heel side supports and the end heel support are connected at a first end to the heel part of the sole and are connected to each other at the other end (fig. 8; figs. 4-7).

Regarding claims 38, 39, 41, and 42, Bathum and Matis each disclose an upper instep section (see annotated fig. below; fig. 7, 120, 122, & 130). The upper is attached to the instep side supports by means of adjustable ties (18 and 24-26; 44). One or more straps (24; fig. 7, 100, 102a, & 102b) are attached to an upperside of the toe part (fig. 1; figs. 4-7). The article of footwear (10; 40) is an athletic shoe (col. 1, lines 43-48; figs. 4-7).



***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of Bathum and Matis.

Regarding claim 40, Bathum and Matis each disclose spike-like traction elements (fig. 4, see unlabeled spike-like traction elements placed at toe part adjacent 16; fig. 5, see unlabeled spike-like protuberances on sole at toe part) mounted on an underside of the toe part of the sole. It is unclear if the structures disclosed by Bathum and Matis meet the definition of a "spike"; however, the traction elements disclosed by Bathum and Matis are equivalent to the structure disclosed by applicant. Both structures encompass the identical function of adding traction to the surface of the sole of a footwear; hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted spikes for the traction elements of either of the footwear of Bathum or Matis since it is old and conventional in the art to incorporate spikes on the sole of a footwear and as a matter of obvious design choice and intended use. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

11. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Ehrlich and Oorei in view of Kataoka et al. (Kataoka).

Regarding claims 26 and 27, Ehrlich does not disclose the toe and instep-heel parts being formed of a composite material of carbon fiber in a thermoplastic resin and Oorei discloses the use of carbon fiber as reinforcement in the rigid material (paragraph [0034]) but does not specify thermoplastic resin being used as a base material; however, Kataoka discloses a sole (fig. 1) for footwear comprising a toe part and an instep-heel part being formed of a substantially inflexible material. The substantially inflexible material may be formed from a composite material of carbon fiber in a thermoplastic resin (col. 4, lines 14-18). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the composite material of Kataoka for the inflexible portions of the sole of either footwear of Ehrlich or Oorei as the material is well known in the art to form a robust and rigid structure as taught by Kataoka. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of Ehrlich and Oorei in view of Kataoka as applied to claims 26 and 27 above, and further in view of Hipp et al. (Hipp).

Regarding claim 28, neither Ehrlich/Kataoka nor Oorei/Kataoka discloses the ball part being formed of a composite material of aramid fiber in a thermoplastic resin; however, Hipp discloses a footwear (51) with a section (12) being formed of flexible

material which is a composite material of aramid fiber and thermoplastic resin (col. 5, lines 34-53). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the composite material of Hipp for the flexible portion of the sole of either footwear of Ehrlich or Oorei as the material is well known in the art to form a strong yet resiliently flexible structure as taught by Hipp. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ailey et al., Ehrlich ('394), Bengtsson et al., Kinsaul, Pan, and Bagnaia et al. (Bagnaia) have been included because they are relevant to the claimed subject matter.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA L. LALLI whose telephone number is (571)270-5056. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLL  
10/13/09

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